Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

REMARKS

The following remarks are made in response to the Final Office Action mailed November 10, 2004, and the Advisory Action mailed April 21, 2005. In that Office Action, the Examiner rejected claims 1-8, 10-15, 17-24, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Anderson, U.S. Patent No. 6,427,165 ("Anderson"), in view of Alexander et al., U.S. Patent No. 6,134,593 ("Alexander"). Claims 9, 16, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Alexander, and further in view of Barrett et al., U.S. Patent No. 5,647,056 ("Barrett").

Along with this Response, Applicant has submitted a Request for Continued Examination. With this Response, Applicant has amended claims 14 and 17, and added new claims 30 and 31. Claims 1-31 are pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1-8, 10-15, 17-24, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Anderson, U.S. Patent No. 6,427,165 ("Anderson"), in view of Alexander et al., U.S. Patent No. 6,134,593 ("Alexander"). Anderson and Alexander, either alone, or in combination, do not teach or suggest "a method of installing components of a software product on a first network server device coupled to a network, the components of the software product providing the first network server device the capability to provide a first service to a plurality of server assisted network devices coupled to the network", as recited in independent claim 1. The Examiner stated that "[r]egarding claim 1, Anderson discloses a method (7:56 – 9:19) ... of installing components of a software product" (Office Action at para. no. 4, page 2). The method disclosed in Anderson referred to by the Examiner discloses a method for selectively obtaining *information* over a network with an information handling system, and does not teach or suggest *installing components* of a *software product* to provide a *first service* to a *plurality of server assisted network devices*.

In a Response to Arguments section of the Final Office Action, the Examiner stated that:

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

Applicants arguments filed 08/05/2004 have been fully considered but they are not persuasive.

Argument (1), Applicant argues on page 9 of response dated 08/05/2004 that in claims 1, 14, and 17 neither Anderson nor Alexander discloses "a method of installing components of a software product on a first network server device coupled to a network, the components of the software product providing the first network server device the capability to provide a first service to a plurality of server assisted network devices".

Response (1), Examiner believes that Anderson does in fact disclose this functionality. As set forth above in claims and as disclosed in Anderson in 7:5 – 8, Anderson discloses obtaining updates and needed programs by downloading the information into a handling system 100. The handling system as then processes the downloaded content as discussed in 3: 7-20. Examiner interprets installing to be loading and processing or executing and Anderson does perform that. (Final Office Action at para. no. 6, pages 7-8).

Anderson at 7:5-8, which was cited by the Examiner in the Response to Arguments, discloses an embodiment in which information is "pushed" to information handling system 100. There is no teaching or suggestion in Anderson that the information handling system 100 is a network server device, or that the "information" that is pushed to information handling system 100 includes components of a software product that provide the information handling system 100 with the capability to provide a service to a plurality of server assisted network devices.

Anderson at 3:7-20, which was also cited by the Examiner in the Response to Arguments, discloses that information handling system 100 can include various types of memories, and includes the statement "[m]ain memory 104 provides storage of instructions and data for programs executing on central processor 102." There is no teaching or suggestion in Anderson that the information handling system 100 is a network server device, or that any of the programs executing on central processor 102 provide the information handling system 100 with the capability to provide a service to a plurality of server assisted network devices.

In the Advisory Action, the Examiner again cited Anderson at 7:5-8, and stated "Anderson shows after downloading, executing stored programs which is equivalent to install (load and execute)." (Advisory Action at page 2). The Examiner appears to be ignoring

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

words used in independent claim 1, which is improper under established precedent. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Claim 1 does not recite "installing" by itself. Claim 1 recites that the components of the software product being installed provide the first network server device the capability to provide a first service to a plurality of server-assisted network devices coupled to the network. By looking only at the word "installing" and ignoring the language in claim 1 that defines what is being installed, the Examiner is going against legal precedent.

The Examiner stated in the Advisory Action that "[r]egarding Applicant's argument on page 8 of Applicant's response that handling system is not network server device. Examiner disagrees. See Anders 6: 43-45, shows handling system can be either node or server." (Advisory Action at page 2). Again, Applicant respectfully disagrees. The cited portion of Anderson does not show that the handling system can be either a node or server. Anderson at 6:41-45 discloses that "[f]urther, method 400 may begin with a program running on information handling system 100 for searching for specific information at step 414 that may be located at a node or server on the network. Such a program may be a search engine program." Thus, the cited portion of Anderson discloses that the handling system 100 may search for information that may be located at a node or server, but says nothing about the handling system 100 itself being a node or server.

One of the requirements of establishing a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. Simply stating that the Examiner interprets installing to be loading and executing does not satisfy the Examiner's burden of establishing a *prima facie* case of obviousness, when the Examiner has failed to identify any disclosure in the cited references that teaches or suggests the limitations addressed above.

As shown in the above block quote, the Examiner set forth an "Argument (1)" and a "Response (1)". Thus, it appears that the Examiner may have intended to respond to the numerous other arguments set forth in the previously filed Response by the Applicant, but the Examiner did not provide an "Argument (2)" and a "Response (2)", an "Argument (3)" and a "Response (3)", etc. In the Final Office Action, the Examiner did not respond to any of the other remarks provided by the Applicant, including the remarks that the cited prior art does

10

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

not teach or suggest: (1) "automatically detecting with the first network server device a first set of server-assisted network devices coupled to the network that are eligible to use the first service"; (2) "automatically transmitting device information based on the detected server-assisted network devices to a second network server device"; (3) "receiving license information from the second network server device based on the transmitted device information"; and (4) "automatically installing components of the software product on the first network server device", as recited in independent claim 1. Thus, Applicant again addresses these limitations below. In the Advisory Action, the Examiner did specifically respond to the first and the second limitations quoted above, and these responses are addressed below.

Anderson and Alexander, either alone, or in combination, do not teach or suggest "automatically detecting with the first network server device a first set of server-assisted network devices coupled to the network that are eligible to use the first service", as recited in independent claim 1. In the Final Office Action, the Examiner repeated the statement from the first Office Action that this limitation is disclosed at 6:45-50 of Anderson. (Office Action at para. no. 4, page 2). Anderson at 6:45-50 discloses that "[a]fter executing any of steps 410, 412 or 414, a list of relevant nodes or servers on the network that contain relevant information may be obtained at step 416. Each of the nodes on the network may be sampled at step 418 for a specific, predetermined parameter value such as connection rate, for example."

There is no teaching or suggestion in Anderson at 6:45-50 that information handling system 100 is a network server device. There is no teaching or suggestion in Anderson at 6:45-50 that any of the nodes accessed by information handling system 100 are server-assisted network devices. The present application states that "Server-assisted network devices 101 according to the present invention include any network device that relies on a server on a network to provide some functionality." (Specification at page 4). There is no teaching or suggestion in Anderson that any of the nodes relies on a server to provide some functionality. There is no teaching or suggestion in Anderson at 6:45-50 that information handling system 100 automatically detects server-assisted network devices coupled to the network that are eligible to use a service to be provided by the information handling system 100.

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

In the Advisory Action, the Examiner stated that "[r]egarding Applicant's argument on page 9, 'automatically detecting ... server assisted network devices...', see Anderson 6:45-47, for searching relevant nodes." (Advisory Action at page 2). Thus, the Examiner quotes certain words from the limitation, ignores other words, and repeats the same citation to Anderson, with no response to Applicant's arguments. As pointed out above, Anderson at 6:45-47 fails to teach or suggest "automatically detecting **with the first network server device** a first set of server-assisted network devices coupled to the network **that are eligible to use the first service**", as recited in independent claim 1.

Anderson and Alexander, either alone, or in combination, do not teach or suggest "automatically transmitting device information based on the detected server-assisted network devices to a second network server device", as recited in independent claim 1. The Examiner indicated that this limitation is disclosed in column 7, lines 4-10 of Anderson, which states: "Such an application may be for content 'pushing' type programs that may be constantly updated wherein the program automatically gathers information from the network and downloads the information to information handling system 100 without intervention by the user. The nodes or servers from which information is pushed to information handling system 100 may be based upon the predetermined parameter values, and not merely upon content of the nodes alone."

As pointed out above, there is no teaching or suggestion in Anderson that information handling system 100 is a network server device, or that information handling system 100 automatically detects server-assisted network devices coupled to the network that are eligible to use a service to be provided by the information handling system 100. Since information handling system 100 does not detect such server-assisted network devices, information handling system 100 cannot transmit device information "based on the detected server-assisted network devices". Anderson does not teach or suggest automatically transmitting *device information* based on the *detected server-assisted network devices* to a *second network server*.

In the Advisory Action, the Examiner stated that "[r]egarding Applicant's argument on page 10, 'automatically transmitting device information ...', see Anderson in FIG. 2, block number 220, which shows obtaining information from node also see column 7, lines 5-10, for pushing information from server." Thus, the Examiner again quotes certain words

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

from the limitation, ignores other words, and repeats the same citation to Anderson, with no response to Applicant's arguments. As addressed above, Anderson fails to teach or suggest "automatically transmitting device information based on the detected server-assisted network devices to a second network server device", as recited in independent claim 1.

Anderson and Alexander, either alone, or in combination, do not teach or suggest "receiving license information from the second network server device based on the transmitted device information", as recited in independent claim 1. The Examiner acknowledged that Anderson does not disclose receiving license information from the second network server device based on the transmitted device information. (Office Action at para. no. 4, page 3). The Examiner stated that Alexander discloses an installer identifier that identifies licensing information for verification purposes during installing in a distributed environment. (Office Action at para. no. 4, page 3). However, like Anderson, there is no teaching or suggestion in Alexander that the "client" computing device 110 is a network server device, or that the client computing device 110 automatically detects server-assisted network devices coupled to a network that are eligible to use a service to be provided by the client computing device. Since client computing device 110 does not detect such server-assisted network devices, client computing device 110 cannot transmit device information "based on the detected server-assisted network devices". Alexander does not teach or suggest automatically transmitting *device information* based on the *detected server-assisted network devices* to a *second network server*. Therefore, the system disclosed in Alexander does not receive license information based on transmitted *device information*.

Anderson and Alexander, either alone, or in combination, also do not teach or suggest "automatically installing components of the software product on the first network server device", as recited in independent claim 1. The Examiner stated that this limitation is disclosed in column 7, lines 5-8 of Anderson, which state: "Such an application may be for content 'pushing' type programs that may be constantly updated wherein the program automatically gathers information from the network and downloads the information to information handling system 100 without intervention by the user." There is no teaching or suggestion in Anderson that the information handling system 100 is a network server device, or that the "information" that is pushed to information handling system 100 includes components of a software product that provide the information handling system 100 with the

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

capability to provide a service to a plurality of server assisted network devices. Anderson does not teach or suggest *installing components of the software product* on a *network server device.*

In view of the above, Anderson and Alexander do not teach or suggest each and every limitation of independent claim 1. There is also no teaching or suggestion to combine Anderson with Alexander. The Federal Circuit has stated "[i]n holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." *Karsten Manufacturing Corp. vs. Cleveland Golf Co.,* 58 U.S.P.Q.2d 1286, 1293 (CAFC 2001). Anderson relates to information gathering while Alexander relates to automatically ordering and unlocking software on a user's system. The two disclosures are in two different technical areas and are not related to one another. There is no suggestion to combine the references in any manner, let alone in a manner that would produce the claimed invention.

In view of the above, independent claim 1 is not taught or suggested by Anderson and Alexander, either alone, or in combination. The Applicant respectfully traverses the rejection of claim 1, and reconsideration and allowance of claim 1 is respectfully requested. Dependent claims 2-8 and 10-13 further limit patentably distinct claim 1, are further distinguishable over the cited prior art, and are believed to be allowable over the cited references. Reconsideration and allowance of claims 2-8 and 10-13 is respectfully requested.

Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 14. Independent claim 14 has been amended herein to further clarify the invention recited in this claim. Independent claim 14, as amended, recites a network server device configured to facilitate the installation of components of a software product, the components of the software product providing the network server device the capability to provide a first service to a plurality of server-assisted network devices coupled to the network. The network service device comprises a controller configured to automatically detect a first set of server-assisted network devices coupled to the network that are eligible to use the first device, a transmitter for automatically transmitting device information based on the detected server-assisted network devices to a second network server device, the device information identifying a quantity of server-assisted network devices, and

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

a receiver for receiving license information from the second network server device based on the transmitted device information. The controller is further configured to automatically install components of the software product on the network server device, thereby configuring the network server device to provide the first service.

For the same reasons as discussed above with reference to claim 1, Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 14, and allowance of claim 14 is respectfully requested. Dependent claim 15 further limits patentably distinct claim 14, is further distinguishable over the cited prior art, and is believed to be allowable over the cited references. Reconsideration and allowance of claim 15 is respectfully requested.

Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 17. Independent claim 17 has been amended herein to further clarify the invention recited in this claim. Independent claim 17, as amended, recites a computer readable medium having computer-executable instructions for performing a method of installing components of a software product on a first network server device coupled to a network, the components of the software product providing the first network server device the capability to provide a first service to a plurality of server-assisted network devices coupled to the network. The method comprises automatically detecting with the first network server device a first set of server assisted network devices coupled to the network and identifying server-assisted network devices in the first set that are eligible to use the first service, automatically transmitting device information based on the detected server-assisted network devices to a second network server device, the device information identifying a quantity of server-assisted network devices, receiving license information from the second network server device based on the transmitted device information, and automatically installing components of the software product on the first network server device, thereby configuring the first network server device to provide the first service.

For the same reasons as discussed above with reference to claim 1, Anderson and Alexander, either alone, or in combination, do not teach or suggest the limitations of independent claim 17, and allowance of claim 17 is respectfully requested. Dependent claims 18-24 and 26-29 further limit patentably distinct claim 17, are further distinguishable over the

15

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

cited prior art, and are believed to be allowable over the cited references. Reconsideration and allowance of claims 18-24 and 26-29 is respectfully requested.

The Examiner rejected claims 9, 16, and 25 under 35 U.S.C. §103(a) as being unpatentable over Anderson in view of Alexander, and further in view of Barrett et al., U.S. Patent No. 5,647,056 ("Barrett").

Dependent claim 9 depends upon independent claim 1. Dependent claim 16 depends upon independent claim 14. Dependent claim 25 depends upon independent claim 17. As described above, Anderson and Alexander do not teach or suggest several limitations of claims 1, 14, and 17. Barrett also does not teach or suggest these limitations of claims 1, 14, and 17. In view of the above, claims 9, 16, and 25, which further limit patentably distinct claims 1, 14, and 17, respectively, and are further distinguishable over the cited prior art, are believed to be allowable over the cited references. Reconsideration and allowance of claims 9, 16, and 25 is respectfully requested.

Newly Submitted Claims

With this Amendment, Applicant has added new dependent claims 30 and 31. Claims 30 and 31 further limit patentably distinct claim 1, and are further distinguishable over the cited prior art. Allowance of claims 30 and 31 is respectfully requested.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-31 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-31 is respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 the amount of $100.00 to cover the fees as set forth under 37 C.F.R. 1.16(b)(c).

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Jeff D. Limon at Telephone No. (541) 715-5979, Facsimile No. (541) 715-8581 or Jeff A.

Amendment and Response
Applicant: Craig McCoy et al.
Serial No.: 09/810,174
Filed: March 15, 2001
Docket No.: 10004231-1 (H302.153.101)
Title: SYSTEM AND METHOD FOR INSTALLING A SOFTWARE PRODUCT ON A NETWORK
SERVER DEVICE

Holmen at Telephone No. (612) 573-0178, Facsimile No. (612) 573-2005. In addition, all

correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
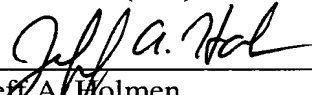Fort Collins, Colorado 80527-2400

Respectfully submitted,

Craig McCoy et al.,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-0178
Facsimile: (612) 573-2005

Date: 5/4/05

JAH: kle

Jeff A. Holmen
Reg. No. 38,492

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of **May, 2005**.

By_____
Name: **Jeff A. Holmen**